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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK E. PHILLIPS and ERIC P. GIBBS

Appeal 2009-003214¹
Application 09/975,748
Technology Center 2800

Decided: August 28, 2009

Before JOHN C. MARTIN, MARC S. HOFF, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is Mark E. Phillips. Br. 1.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-5 and 7-20. Claim 6 stands objected to for depending from a rejected claim.

We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

A. Appellants' invention

Appellants' invention is a system that permits a user to implement a form of "jukebox" on a portable audio device. Specification 3:2-3. The jukebox manager allows the user to create, edit, and utilize a playlist comprising one or more data files. *Id.* at 3:3-5. In a typical implementation, each data file is a separate musical track. *Id.* at 3:5.

Appellants' Figure 3 is reproduced below.

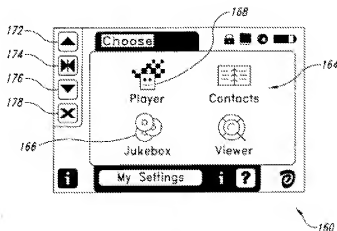


Fig. 3

Figure 3 is a screen display illustrating the operation of Appellants' invention. *Id.* at 2:24-25. When power is first applied to the system, the

display may be configured to illustrate a main menu including a series of icons 164, such as a jukebox icon 166, a player icon 168, and the like. *Id.* at 9:1-4. Activating the Scroll Up button 172 or the Scroll Down button 176 will cause the display to highlight a different one of the icons 164, such as by reverse video. *Id.* at 9:11-13. When the desired icon is highlighted, the user may activate the selection button 174 to activate the selected function. *Id.* at 9:13-15.

Figure 4 is reproduced below.

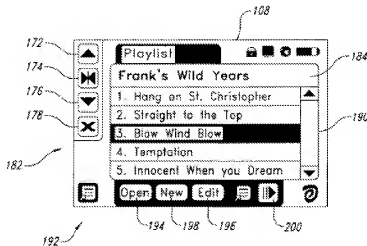


Fig. 4

Figure 4 illustrates a sample screen display 182 resulting from activation of the jukebox icon 166 (Fig. 3) followed by the selection of a particular playlist. *Id.* at 9:16-18. Screen display 182 includes a playlist title display 184 to display the name of the selected playlist. *Id.* at 9:19-20. The user may simply activate the playlist to play musical tracks in the predetermined sequence shown in the playlist by pressing the Selection

control button 174. *Id.* at 9:20-22. When a display list (e.g., list of tracks) is first shown on the display 108, the first entry in the playlist may be automatically selected and indicated using, by way of example, reverse video. *Id.* at 9:22-24. The user may also scroll through the selected playlist using a scroll bar 190 in a well-known fashion or, alternatively, simply by touching the touch-sensitive display 108 at a point corresponding to the desired musical track. *Id.* at 9:24-27. The system also may be configured to allow the user to scroll through the selected playlist using the Scroll Up button 172, a Scroll Down button 176, and the Selection control button. *Id.* at 9:27 to 10:2.

The user may also control the operation of the system to open or edit playlists, or create new playlists using additional programmable control buttons 192 on a predetermined portion of the touch-sensitive display 108. *Id.* at 10:3-5.

The musical tracks of the selected playlist may be played sequentially in the sequence originally specified by the user when creating the playlist, in a new sequence specified by the user at the present time, or in some other fashion, such as random selection. *Id.* at 16:2-5.

B. The claims

Appellants argue all of the rejected claims as a single group. The independent claims before us are claims 1, 12, and 18, of which we select claim 12 as representative. 37 C.F.R. § 41.37(c)(1)(vii). Claim 12 reads:

12. A method for the automatic control of music selection in a hand-held portable multi-media device, the method comprising:

storing a plurality of music data files, each music selection data file having identification data associated therewith;

sensing user operation of an input device to select identification data associated with desired music data files for the playlist;

selecting a portion of the music data files to generate the playlist based on the user selected identification data;

processing the selected music data files with a CODEC to convert the selected music data files to audio data; and

providing the audio data to an output for connection to an audio output device.

Claims App., Br. 14.

C. The reference and rejection

The Examiner relies on the following reference:²

² Burrows, U.S. Patent 6,377,530 B1 (filed Feb. 12, 1999; issued Apr. 23, 2002), cited as “pertinent, because it discloses most of the features of the present invention and specifically discloses the use of a plurality of data types, a battery, and etc . . .” (Final Action 5; Answer 6), will be given no consideration because it is not relied on in the statement of the rejection. *See* MPEP § 706.02(j) (8th ed., rev. 6, Sept. 2007) (“Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection.”) (citing *In re Hoch*, 428 F.2d 1341, 1342 n.3 (CCPA 1970)). For the same reason, we will give no consideration to the Examiner’s statement that “the current claims can be rejected using the Apple iPod device.” Answer 7.

Winsky et al. (Winsky) US 5,739,451 Apr. 14, 1998

Claims 1-5 and 7-20 stand rejected under 35 U.S.C. § 103(a) for obviousness over Winsky in view of Official Notice that it was “well known in the art to use Codecs as converters and Metatags for data filing.”
Answer 3-4.

THE ISSUE

Appellants have the burden on appeal to show reversible error by the Examiner in maintaining the rejection. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” (citation omitted)).

The sole issue before us is whether Appellants have shown that the Examiner erred in finding that Winsky discloses or suggests a “playlist.”

PRINCIPLE OF LAW

Application claims are interpreted as broadly as is reasonable and consistent with the specification, *In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir. 2002), while “taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification,” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

WINKSY

Winsky discloses a hand held electronic reference device that enables a user to identify a song from available identification information, such as some lyrics, and/or from a segment of its melody line. Winsky, col. 1, ll. 7-10. Winsky does not employ the term “play list” or “playlist.”

Figure 1 of Winsky is reproduced below.

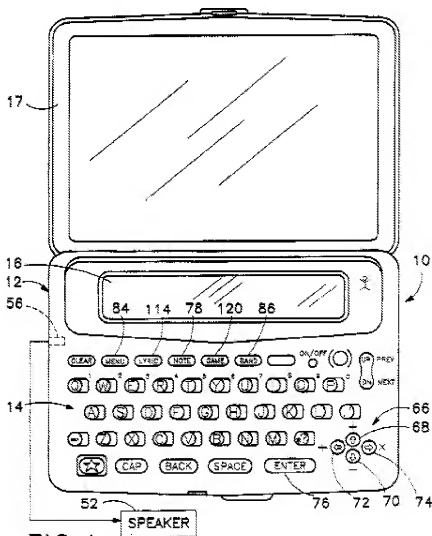


FIG. 1

Figure 1 is a plan view of a platform having a keyboard and a display in Winsky's hand held electronic music reference machine. *Id.* at col. 3, ll. 2-4.

As shown in Figure 3 (not reproduced herein), Winsky's machine has a database 20 that includes a first memory portion 22 having an area 24 storing song titles and another memory area 26 storing at least some lyrics for each song whose title exists in memory area 24. *Id.* at col. 3, ll. 43-48. Memory portion 22 further includes areas 28, 30, 32, 34, 36, and 38 respectively storing band or artist names, songwriter names, the highest chart positions attained by the various songs, the years in which the highest chart positions were attained, Hall of Fame listings, and recording labels. *Id.* at col. 3, ll. 48-53. Database 20 also includes (a) a memory portion 44 that stores, for each song, a segment that is preferably the most memorable and well known portion of the song (*id.* at col. 3, ll. 62-66) and (b) a memory portion 48 that stores note structure information, i.e., information pertaining the directions of change of pitch values of melody segments. *Id.* at col. 4, ll. 9-11.

Figure 4 is reproduced below.

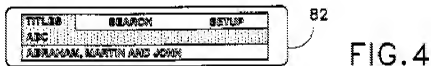


Figure 4 shows a main menu display screen and the beginning of a master list of song titles in the electronic music reference machine. *Id.* at col. 3, ll. 13-16. This screen, which includes a "Titles" selection, a "Search"

selection, and a “Setup” selection, is displayed upon initialization of the device or upon pressing of a specialized key 84 (Fig. 1) labeled “Menu.” *Id.* at col. 5, ll. 40-44. The desired selection is made by actuating “Enter” function key 76 when the desired selection is highlighted, the highlighting being shifted among the different selections by using left and right directional keys 72 and 74 (Fig. 1). *Id.* at col. 5, ll. 44-48.

When “Search” is selected from the main menu, display 16 shows a list (not depicted in the drawings) of nine search parameters or filters including song titles, bands, song writers, song position, chart position, year, hall of fame status, record labels, lyrics, and melody line. *Id.* at col. 5, ll. 51-55.

Figures 5A-5E illustrate successive display screens produced by the machine in searching for songs by a particular band or recording artist. *Id.* at col. 3, ll. 17-21. Specifically, during a search of the band list, the user selects the artist of interest by using up and down directional keys 68 and 70. *Id.* at col. 6, ll. 17-19. In response to actuation of Enter function key 76, a list of song titles for the highlighted recording artist is displayed. *Id.* at col. 6, ll. 19-21.

After the song of interest is highlighted, actuation of special function key 78 causes selector module 80 to retrieve the stored reproducible musical segment for a highlighted song from memory portion 44 and to feed the retrieved segment to synthesis module 46 for playback via speaker 52. *Id.* at col. 6, ll. 21-27.

Whenever a song title is highlighted on display 16 and Enter function key 76 is actuated, display control 58 accesses memory portion 22 to obtain identification information and lyrics for the highlighted song. *Id.* at col. 6, ll. 28-32. Figures 6A-6H illustrate a sequence of successive screens 98, 100, 102, 104, 106, 108, 110, and 112, which display the identification information and lyrics to the user. *Id.* at col. 6, ll. 32-35.

Appellants deny that Winksy discloses a “playlist,” which Appellants argue is “essentially a list of identifiers that identify a set of audio files that may be played sequentially, or played in some other order, upon user selection of a particular playlist for rendering by the portable audio device.”

Br. 7. Instead, Appellants argue, Winksy’s “electronic music encyclopedia is designed to allow a user to identify one particular song based on various criteria, rather than as a music-playing device.” *Id.* at 8.

Appellants’ interpretation of the claim language is unduly narrow in two respects. The first respect is that claim 12 does not require that the recited “playlist” represent more than one music data file. It is evident from Appellants’ Specification that the term “playlist” does not, in and of itself, imply a plurality of music data files. *See* Specification 3:3-5 (“A jukebox manager allows the user to create, edit, and utilize a playlist comprising one or more data files.”). Regarding this statement in the Specification, Appellants argue:

While a playlist may contain a single song at any given time, a playlist may also accommodate multiple songs at other times, depending on a user’s wishes. A playlist can be edited, created, and updated, as described beginning on line 24 of page 9 of the

current application. A single, displayed song title does not provide such functionality.

Reply Br. 9. This argument is unconvincing because the language of claim 12 has not been shown to require that the recited “playlist” be capable of representing multiple songs or of being edited and updated.

Furthermore, even assuming for the sake of argument that the recited “playlist” must be interpreted as representing multiple music data files, claim 12 does not additionally require that *all* of the multiple music data files be played (sequentially or otherwise) upon user selection of the playlist, as argued by Appellants. Rather, the claim language is broad enough to read on selecting a single song to be played from a playlist. As a result, claim 12 reads on using the Winksy device to play a single highlighted song from a list of songs, such as a list of songs by a particular artist. Winksy, col. 6, ll. 19-27. Such a list can accurately be characterized as a “playlist” because it is a list of songs from which a user can select a song for playing.

Appellants have not provided any persuasive evidence in support of their narrower interpretation. Although, as noted by Appellants (Reply Br. 8-9), their Specification explains that “[t]he user may simply activate the playlist to play musical tracks in the predetermined sequence shown in a playlist by pressing the Selection control button 174” (Specification 9:20-24) and employs similar language at page 15, line 24 to page 16, line 5, those passages represent examples of a playlist rather than constituting a definition of that term.

Also, Appellants' argument that "[t]he term 'playlist' is a well-understood and well-recognized term in the field of audio-file-rendering devices, such as the Apple iPod® device" (Br. 9) is unpersuasive for several reasons. First, as acknowledged in the Reply Brief (at 10) in responding to the Examiner's statement that "the current claims can be rejected using the Apple iPod device" (Answer 7), the evidence of record fails to establish that the Apple iPod® device was released prior to Appellants' filing date. Second, even assuming for the sake of argument that the selection of a playlist in the Apple iPod® device necessarily resulted in the playing of multiple songs, there is no evidence of record establishing that the term "playlist," when given its broadest reasonable interpretation apart from its use in the Apple iPod® device, was understood to require such operation.

Appellants' further argument that "Winsky [sic] does not even disclose the capability of playing one entire song, instead referring to segments of songs that are played to assist a user in recollecting and identifying a song" (Reply Br. 10) is unconvincing because claim 12 does not do limit the recited "music data files" to the files of entire songs.

Appellants have therefore failed to show that the Examiner erred in finding that Winsky discloses or suggests the claimed "playlist."

DECISION

The rejection of claims 1-5 and 7-20 under 35 U.S.C. § 103(a) for obviousness over Winsky is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

babc

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